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REMARKS

At the outset, Thomas McGarry and applicants' attorney Deshmukh takes this opportunity to sincerely thank Examiner Van Doren for conducting an interview on October 26, 2006 that addressed the outstanding rejections. Demonstration of an on-line version of the present invention was also conducted for the Examiner's consideration.

Claims 1-10, 34-37 and 49 were rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In order to overcome the rejection, claims 1 and 34 have been amended to overcome said rejection. The specification has also been appropriately amended in conformity with recited language of claim 34. Support for amending claim 34 and the corresponding amendment in the specification can be found in formula xxvii in claim 34.

The rejection of claims 1-10, 34-37 and 49 under 35 U.S.C. § 103 (a) as being unpatentable over US 6,771,290 to Hoyle in view of US 6,771,290 to Bargnes et al. (hereafter Bargnes) is respectfully traversed in view of the following remarks:

Hoyle is directed to an interface that remotely spies on a computer user's behavior and searching patterns to "push advertise" targeted banner or pop up ads on the user's computer screens including burrowing into other software programs residing on the user computer. In simpler terms, Hoyle's interface is a type of a benign spyware or adware that remotely tracks what users do on their computers and then secretly sends that information over the internet to remote ad monitoring sites.

Hoyle's graphical user interface (GUI) 14 along with an advertising and data management module (ADM) 18 forms a subterranean portion of a typical freeware or shareware type computer program (client software application 10) that is **completely invisible to the computer user** (Fig 4, column 9, lines 42-

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64). Upon the first start-up of the typical freeware or shareware (client software application 10), demographic information about a computer user, such as age, gender, hobbies, interest, e-mail addresses, etc. is first collected **before the freeware or shareware type computer program can be downloaded on to a user's computer** (Column 1, lines 24-47 together with Fig 8 and column 25, lines 66-67 and column 26, lines 1-9). Holyle's interface then sends, via internet, not only the collected demographic information about the user but also the information about other computer programs, such as Microsoft Word® or IBM Lexis® software programs that may be residing on the user's computer to an advertisement agency by using system hooks (column 19, lined 18-36 and column 20, lines 29-34). Holyle's interface plays no role the software program itself, other than collecting information about the computer usage.

Hoyle's interface then continuously tracks and monitors the types of websites user visits and sends this information to the advertisement agency, which can then tailor an ad based on the user's demographic profile, computer activity, usage, hobbies and interests and sends such a targeted banner or pop up ad to that specific user (Column 23, lines 7-31). User's computer usage is monitored by the Hoyle's interface **without the user's knowledge** on the user's computer even when the user is not connected to the internet and once such a connection is established, Hoyle's interface then uploads packets of the relevant user activity to the advertisement agency.

In addition, the advertisement agency can also charge the banner or pop up advertisers a fee that depends upon the number of user hits, as determined by the number times the user "clicks" or "accesses" the banner or pop up ads being "pushed" on to the user by the advertisement agency via Hoyle's interface (column 32, lines 23-50). **The user has NO control over what is being "pushed" on the user through the Hoyle interface. By contrast, it is the**

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customer who determines and chooses what business tools he or she wishes from the business tool menu in the current process. These two activities are patentably distinct from one another.

Thus, it is clear that process of Hoyle is directed to a process that is never seen by the computer user, thus it is not and cannot provide ANY business solution for solving any of customer's business problems. No such process or device is either contemplated or possible in the current invention.

Moreover, the process of Hoyle is least interested in the computer user's business interests but only in taking care of interests of third parties and generating revenues from such ads to the advertising agency that is "push" advertising such ads to a computer user. As a result, it is not seen why one of ordinary skill in the art would arrive at present invention in view of Hoyle.

Unlike Hoyle, in claim 1 of the present invention NO downloading of any software occurs from the host computer to the client computer. In step (b) of the present invention, customer's log on procedure is patentably distinct from that in Hoyle. The remarks in the Office Action that in Hoyle once a log on procedure is completed, the customer computer can access the host computer to accessing a main menu comprising one or more business tool is respectfully traversed. In Hoyle, the first log on allows the user to **download a software to his or her own computer**, which is patentably distinct from what occurs in the present invention. Such a download is not the same or equivalent to access a menu that is located on the host computer. Thereafter, in Hoyle after the first log in, the underlying interface extracts information about the user's computer activity without the knowledge or any affirmative act by the user (Fig. 9). No such process occurs or is even contemplated in the current invention. Thus, it is not seen why current step (b) of in claim 1 is either taught or suggested by Hoyle.

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Unlike what is stated in the Office Action, there is no suggestion or teaching in Hoyle of entering customer business data in Hoyle. Similarly, no business data are entered or can be entered and no means are provided in Hoyle to enter any such data. Furthermore, no processing of such business data occurs or can occur in Hoyle.

Unlike what is stated in the Office Action, there is no suggestion or teaching in Hoyle of requesting a user to make payment before allowing access, such as in step (c) in current claim 1. At column 36, lines 16-33, Hoyle discloses allowing the user to buy a virtual pre-paid cash card which the user can use to make on-line purchase hopefully through one of the banner ads or pop ads produced by Hoyle interface on the client computer. Such purchase can occur any time for any reason. All of this activity occurs not for the benefit of computer user but for the benefit of third party ads posted by Hoyle interface. By contrast, in the current claim 2, customer has to deposit a payment before he or she is allowed to access the menu containing various business tools.

In Hoyle the user is only requested to make a log on for the first time. Once the log on procedure is completed a freeware or shareware software is then downloaded in the user computer. By contrast, in claims 3 and 4 the log on procedure allows the customer access to the menu containing various business modules on a server. NO software is downloaded in the current invention. Moreover, in Hoyle whether the user is connected to the server or not, the user has to be identified by the Hoyle interface residing on user's computer to monitor and track his or her customer use and activity. In the current process, the purpose is to allow the customer to access the menu, which resides only on a host computer and not for monitoring of customer activity on the customer's computer. Thus, it is not seen why current claims 3 and 4 are obvious over Hoyle.

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The statement in the Office Action on page 7, lines 9-10 and page 10, lines 2-5 and 18-19 that Hoyle's system is like a Windows® operating system (supplied by Microsoft Corporation of Redmond, Washington) is respectfully questioned. Figure 1 of Hoyle discloses a GUI module 12 of the downloaded shareware that interacts with user's operating system, such Windows® 98 or Windows® NT (supplied by Microsoft Corporation of Redmond, Washington). All it does is to manage, i.e., track and monitor and display the banner ads and pop ads being "pushed" by Hoyle whenever, the user, for examples logs on internet using an internet software, such as Windows® Explorer (supplied by Microsoft Corporation of Redmond, Washington). The application icons in Windows® 98 operating system residing on the user computer are patentably distinct from the business tools residing on the host computer of the present system. Unlike the current process, NO log on is required in Hoyle to access these operating system icons, which most of the computers are supplied with when purchased. Thus, it is not seen why one of ordinary skill in the art would arrive at the business tools of the present invention by simply knowing how to use the icons of a standard operating system, such as Windows® 98.

Hoyle expressly notes on column 10, lines 13-20 that no special computer skills are necessary to operate client software application 10 of Hoyle. Thus, it is not seen why claims 6 and 7 which are directed to provided the client with assistance in using business tools is obvious in view of Hoyle. Moreover, it will not be obvious to one of ordinary skill in the art to require the user special training to use application 10 in Hoyle, as it will defeat the very purpose of Hoyle, namely to track and monitor user's computer usage so that tailor-made banner ads can "push advertised" onto the unsuspecting user.

Hoyle at column 25, lines 4-25 discloses verifying the user's logon information and demographic data WITHOUT the user's knowledge so that third

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party tailor-made banner ads can be push advertised on the unsuspecting user. The aforementioned entire verification process is NOT for the benefit of the user but for the benefit of third party advertisers who wish to entice the user to buy their products displayed in the banner ads tailor-made by the Hoyle process. Thus, it is not seen why claim 8 is obvious over Hoyle.

The on-line computer help provided for in Hoyle at column 14, lines 33-37 refers to a shareware which is downloaded in the user's computer and refers to a conventional web search, which can be carried out by using a search engine, such as Google. The help is proved for the user to showcase product capability and directions for using the product. By contrast in claim 9 the on-line help provides explanation of business solution, which is patentably distinct from what is disclosed in Hoyle.

There is no suggestion or teaching in either Hoyle or in Bargnes that would lead one of ordinary skill in the art to combine these two references absent any suggestion or teaching therein. It would not be obvious for one of ordinary skill in the art to combine the manipulations of icons of operating systems, such as Windows® 98 taught by Hoyle with the business applications disclosed in Bargnes to arrive at the present invention.

Unlike the current invention, as noted in steps 31 and 32 of Figure 2, and page 6, lines 8-11 of the current specification, there is no dedicated algorithmic module of a chosen business tool used to carry out a business analysis of the chosen business tool either in the Hoyle or in Bargnes; nor is there any suggestion or teaching in either of these references to arrive at the claims of the present invention. Moreover, as noted in Figure 2 in Bargnes, the process therein utilizes a single business module 60 (also column 3, lines 49-67) to conduct seven business applications, such as "Customer Financial Data, Forms & policies-Business Plan-Operating Manual, etc. which then interacts with a

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single transaction module 64. As noted at column 3, lines 49-67 of Bargnes, the user must input customer financial data 80, customer, facility and personnel information 84, customer assessment of priorities 88, and production shift information 89 in order for business analysis module 60 to identify best practices 92, analytical worksheets 96, and forms and policies of the business 100 in business module 60 to get specified outputs. See also Figure 2 of Bargnes. No such architecture is utilized nor is it desired in the current invention (See Figures 3B and 3C in the current specification). One of ordinary skill in the art would appreciate that a complex single business/transaction module would be far more difficult to revise or upgrade than series of distinct dedicated modules, which can be independently revised or upgraded without affecting the whole software architecture. In addition, the user in the current invention is not required to enter a substantial amount of data to get the output that may not require such voluminous data entry. As a result, the process of present invention is substantially less cumbersome than the process disclosed in Bargnes. As noted above, the current invention utilizes an entirely novel arrangement whereby each business tool recited in claim 5 has independent input/output architecture contained within its own algorithmic module. As a result, the user is provided with a substantial flexibility to tailor his or her business priorities and interests. Such processes and software associated therewith were neither suggested nor would be possible in the cited art taken alone or in combination.

There is no teaching in Hoyle and Bargnes of providing a business solution that identifies process problems and poor financial performance of a customer. Moreover, there is no suggestion or teaching in Bargnes of either utilizing steps (c), (d), (e) and (f) as recited in claim 1 nor would these steps occur to one of ordinary skill in the art in view teachings in Hoyle and Bargnes taken alone or in combination.

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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the foregoing, it is respectfully submitted that there is no motivation, teaching or suggestion in either of these references taken alone or in combination to address the problem addressed by the process of present invention, namely conducting analysis of customer's business based on the information entered by the customer and then providing business solutions to the customer business problems. As a result, the Office has failed to meet the *prima facie* obviousness test and therefore the burden of proof required in establishing obviousness of the current process is still with the Office.

New claim 59 has been added for the Examiner's consideration. Support can be found in claim 1.

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Should the Examiner wish to discuss any issues involved in this application, the Examiner is respectfully invited to contact the undersigned at the telephone number listed below.

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